

REMARKS/ARGUMENTS

Claims 1-18 are pending. By this Amendment, claims 2-7 and 9-16 are amended. Support for the amendments to claims 2-7 and 9-16 can be found, for example, in original claims 2-7 and 9-16. The amendments to claims 2-7 and 9-16 are made solely to improve their clarity. No new matter is added. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

Rejection Under 35 U.S.C. §103

The Office Action rejects claims 1-18 under 35 U.S.C. §103(a) over WO 02/02684 to Malz et al. ("Malz")* in view of U.S. Patent No. 5,175,349 to Gupta et al. ("Gupta"). Applicants respectfully traverse the rejection.

Claim 1 recites "[a] mixture comprising: (a) isocyanate; and (b) stabilizers with a molar mass of from 600 to 10000 g/mol that comprise at least two phenolic groups" (emphasis added). Claim 2 recites "[a] mixture comprising: (a) isocyanate; and (b) stabilizers that comprise at least two phenolic groups bonded to one another by way of, as a bonding radical, a polyol with a number-average molecular weight of from $40 \times F$ to $1000 \times F$ g/mol, wherein F is a number of phenolic groups in the molecule" (emphasis added). Claim 5 recites "[a] mixture comprising: (a) isocyanate; and (b) a stabilizer comprising at least one compound given by formula (X) and/or (XX) ..." (emphasis added). Malz and Gupta do not disclose or suggest such mixtures.

As is evident from their respective terms, each of claims 1, 2 and 5 is directed to a combination of isocyanate and particular stabilizers requiring, *inter alia*, compounds with two phenolic groups. As correctly pointed out in the Office Action, Malz discloses stabilizers for thermoplastic polyurethanes that include compounds with two phenolic groups. *See, e.g.,*

* Discussion of Malz is made with reference to U.S. Patent No. 6,995,230, which the Office Action asserts is an English-language equivalent of Malz.

Malz, Abstract. However, it is undisputed that Malz fails to disclose such stabilizers in a mixture with isocyanates. *See* Office Action, page 3. The Office Action relies on Gupta for its disclosure of using 4-hydroxyphenyl propionic acid compounds to stabilize polyisocyanates (*see* Gupta, column 1, lines 5 to 7), and asserts that it would have been obvious in view of Malz and Gupta to employ the stabilizer of Malz in a mixture with isocyanates as provided in Gupta. *See* Office Action, page 3. Applicants respectfully disagree.

Malz discloses that a particular type of compounds can be used to stabilize thermoplastic polyurethanes. *See* Malz, column 1, line 44 to column 2, line 25. There is nothing in Malz that remotely discloses or suggests that such compounds would have any particular usefulness in stabilizing isocyanates. Gupta discloses entirely different compounds from those disclosed in Malz. There is no disclosure in Gupta of compounds including, e.g., two phenolic groups. The Office Action provides no rationale for why one of ordinary skill in the art would conclude that compounds having the structures described in Malz could or should be used in the mixtures described in Gupta. It is well-settled that a proposed modification or combination must be supported by a "reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (U.S. 2007). A *prima facie* case of obviousness has not been made.

As discussed above, a *prima facie* case of obviousness has not been made. However, even if a *prima facie* case were made, such case is rebutted by the results shown in the present specification – "[a] *prima facie* case of obviousness ... is rebuttable by proof that the claimed compounds possess unexpectedly advantageous or superior properties." *See* MPEP §2144.09 (citing *In re Papesch*, 315 F.2d 381 (C.C.P.A. 1963)). The Examples of the present specification demonstrate that mixtures, such as recited in claims 1, 2 and 5, are more stable

than mixtures including isocyanates and commercially-available phenolic stabilizers, of the type that are described in Gupta. In particular, the Examples of the present specification demonstrate that mixtures such as recited in claim 1, 2 and 5 show dramatically superior performance in resisting discoloration in comparison to mixtures of isocyanate and known stabilizers, such as disclosed in Gupta. *See, e.g.*, present specification, page 11, Table 1. These results are objective evidence of the improvements of the mixtures of claims 1, 2 and 5 over known mixtures, as in Gupta, and thus these results rebut any suggestion that it would have been obvious to modify the mixtures of Gupta by incorporating the stabilizers of Malz.

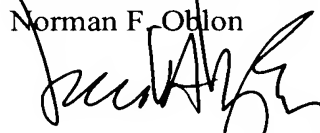
As explained, claim 1 would not have been rendered obvious by Malz and Gupta. Claims 2-18 depend from claim 1 and, thus, also would not have been rendered obvious by Malz and Gupta. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Conclusion

For the foregoing reasons, Applicants submit that claims 1-18 are in condition for allowance. Prompt reconsideration and allowance are respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



Jacob A. Doughty
Attorney of Record
Registration No. 46,671

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)